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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,216	02/10/2005	Mubarik Mahmood Chowdhry	265070US0PCT	6422

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EXAMINER	
LEE, RIP A	

ART UNIT	PAPER NUMBER
1796	

NOTIFICATION DATE	DELIVERY MODE
08/19/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/524,216	CHOWDHRY ET AL.	
	Examiner	Art Unit	
	RIP A. LEE	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *June 4, 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12,14 and 16-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12,14 and 16-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This office action follows a response filed June 4, 2008. Claims 1-12, 14, and 16-21 are pending.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-12, 14, and 16-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what is meant by the term "polymerizing a miniemulsion" since the claim recites the step of catalyzing polymerization of one or more olefins. The miniemulsion would contained polymerized material, and therefore, one can not polymerize a miniemulsion as recited in the instant claims.

3. Claims 1-12, 14, and 16-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The description of structure (I) is incomplete since the number of donor ligands L^1 and the number of anionic ligands L^2 has not been indicated. Therefore, the chemical identity of compounds of structure (I) is not particularly pointed out and distinctly claimed.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 2, and 4-12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of Schmid *et al.* (U.S. Patent No. 6,800,699). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons. Claims of the patent are drawn to a process of making aqueous polymer dispersion having an average droplet diameter $\leq$ 100 nm (*i.e.*, a miniemulsion) by polymerizing at least one olefinically unsaturated compound in the presence of dispersant and a complex of formula (Ib) in which M is a group 7-10 metal and R^4 to R^7 is a C_6-C_{14} aryl, identically or differently substituted by one or more halogens, or singly/multiply halogenated C_1-C_{12} alkyl groups. Halogens and singly/multiply halogenated C_1-C_{12} alkyl groups are electron withdrawing groups. Claims 10-14 of the patent are substantially the same as claims 6-10 of the instant application.

Claim Rejections - 35 USC § 102 / 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 11 and 12 rejected under 35 U.S.C. 102(e) as being anticipated by Tomov *et al.* (WO 00/20464; equivalent U.S. 6,737,483 relied upon for translation and indexing).

Tomov *et al.* discloses a mini-emulsion of polymerized ethylene (examples 4 and 5); mini-emulsions have a droplet diameter of less than 1 μm (col. 8, line 21). The claim is presented in product-by-process format. It is well settled that where product by process claims are rejected over a prior art product that appears to be the same, the burden is shifted to the Applicant to establish an unobviousness difference, even if the production processes are different. Furthermore, the patentability of a product claim rests on the product formed, not on the method by which it was produced. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983), *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

8. Claims 14 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomov *et al.* in view of Kristen *et al.* (WO 01/44325; equivalent U.S. 7,129,292 relied upon for translation and indexing).

The discussion of the disclosures of the prior art from paragraph 7 of this office action is incorporated here by reference. Tomov *et al.* is silent with respect to particular end use for polyolefin mini-emulsions. Kristen *et al.* teaches that polyolefin emulsions find use for surface sizing, treating textile, leather, carpet backing, molded foams, adhesives, paints, and pharmaceutical preparations (col. 22, lines 58-64; also col. 22, lines 65 - col. 23, line 58). It would have been obvious to one having ordinary skill in the art to use polyolefin mini-emulsions of Tomov *et al.* in the applications taught in Kristen *et al.*, and one of ordinary skill in the art would have expected such an embodiment to work with a reasonable expectation of success.

Response to Arguments

9. Applicant's arguments filed June 4, 2008 and March 15, 2007 have been reconsidered, and they are persuasive. Upon further review, it is concluded that the instant invention is not fully anticipated by the teaching of Schmid *et al.* The embodiment cited in the office action of June 18, 2007, in which a mini-emulsion is to be prepared in the presence of a complex (Ib) in which one of R^4 to R^7 is a C_6-C_{14} aryl group that is substituted by one or more halogens or singly or multiply halogenated C_1-C_{12} alkyl groups is not so fully disclosed that the disclosure of Schmid *et al.* is anticipatory. Consequently, the rejection has been withdrawn.

Applicant further points to the fact that Schmid *et al.* is disqualified as prior art under 35 U.S.C. 102(e) and 102(a) since at the time the instant invention was made, the instant invention and that of Schmid *et al.* were commonly owned (June 4, 2008 response, page 8, line 6).

Conclusion

10. This action is non-final. The subject matter of claim 21 is free of the prior art and would be allowed upon appropriate corrections to overcome the rejection of the claim under 35 U.S.C. 112, 2nd paragraph, set forth in paragraph 3 of this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu S. Jagannathan, can be reached at (571)272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

/Rip A. Lee/
Art Unit 1796

August 13, 2008